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| MARVIN NACHMAN 315 SAYBROOK RD VILLANOVA, PA 19085 | | | | |
| | | | EXAMINER LEE, CHEUKFAN | |
| | | | ART UNIT 2622 | PAPER NUMBER 36 |

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AB
ABC
AB
112, 1st description
priority
reference for rejection
different issues

Office Action Summary

Application No.

08/669,056

Applicant(s)

NACH MAN

Examiner

Chenckfan Lee

Group Art Unit

2622

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9-5-03.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 27-29, 32-48, and 52-54 is/are pending in the application.
- Of the above claim(s) 28 and 37 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 27, 29, 32-36, 38-48, and 52-54 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. Applicant's election with traverse of Group I invention including claims 27, 29, 32-36, 38-48, and 52-54 in Paper No. 35 is acknowledged. The traversal is on the ground(s) that all of the independent and dependent claims are method claims, which share a generic basis, independent claims 27, 28, 36, 43, 52, and 54 recognize that a facsimile machine generates analog or digital signals in facsimile formats which contain scanned image data that can be transferred through a passive link without interception from the facsimile machine to the computer, independent claims 36, 43, 53, and 54 recognize that a computer can send analog signals if equipped with a modem, or digital signals, which contain image data that can be transferred through passive link without interception from the computer to the facsimile machine for printing, and therefore, it is obvious all the claims in Groupings I, II and III share a single inventive concept. This is not found persuasive.

First, in the restriction requirement (Paper No. 34) mailed Aug. 13, 2003, there were only two groups of claims, Group I and Group II. Second, Applicant's election filed Sept. 5, 2003 is responsive to the Paper No. 34. Therefore, remarks should be made with regard to two groups, not three. Further, it is not what the Groups I and II share that is used in the determination of whether restriction is required, but it is what is different between the Group I claims and the Group II claims that is critical in making such a decision on restriction. According to MPEP § 806.05(c), in the instance case, as stated in section 4 of the restriction requirement mailed Aug. 13, 2003, the inventions are distinct, each from the other. Inventions I does not require the particulars of Invention II because the using of the Fax and PC to scan and print in invention I

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does not require the type or types of connections specified in Invention II including the initiation(s) specified. Invention II has separate utility such as initiation of connection between a Fax and a PC which are not used to scan and print as the Fax and PC of Invention I do.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 28 and 37 drawn to an invention nonelected with traverse in Paper No. 35. A complete reply to a final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. **This Office action is NOT MADE FINAL**, however.

3. The specification is objected to because page 15, lines 9-11 recites "Fig. 2j." It is unclear if this is a typo since there is no Fig. 2j in the drawings in file.

4. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Claim 34 depends upon claim 27. Claim 27 claims digital data transfer. Claim 34 is understood to include all limitations of claim 27. Claim 34 claims "including replacing the digital signal with an analog scanned image source signal from the facsimile machine to said computer through a modem interface." This combination of claim 27 limitation and claim 34 limitations is confusing as in how it is possible for the analog data transfer of claim 34 to take

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place since the computer of claim 27 is conditioned "to receive digital facsimile signals representing data on a scanned document." Claim 27 might have replaced the digital signal with an analog signal, but the computer is not claimed in anywhere to be able to receive analog signals. Further, "a modem interface" is claimed in claim 34. However, it is unclear where the modem interface is resided. The residence of the modem interface should be clear for the correct interpretation of the claim(s) because of the claimed "passive link" (claim 27).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 43-48, 53, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Simon (English translation of German Patent No. DE 43 12 136 A1).

Regarding claims 43, 53 and 35, taken the "printer" as the claim limitation (and thus, "scanner" is not considered), Simon discloses a method of using a facsimile device FAX as a printer for a person computer PC including creating a direct communication link between the FAX and the PC (Fig. 3, page 5, line 15, page 6, line 7 - page 7. In accordance with the communication link in conformity with the invention (Fig. 3), the possibility is created to undertake a direct communication by way of a single, serial link between a PC and a FAX (FK)

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without the aid of a telecommunications network. Hard- and software components of the PC, which are being used for the communication to the networks, are additionally equipped with the specific handshaking procedures of the network/networks (page 6). The direct (interface) connection or link of the FAX (FK) takes place at the interface - provided on the personal computer for the purposes of an interconnection to the telecommunications network - by using the conventional interconnection technique, and by simulating the elements, necessary for the communication with a facsimile FAX, and the procedures of the telecommunications network in the PC (page 6 - page 7). With the help of the invention, the opportunity is provided for PCS to also utilize the abundantly existing conventional facsimiles (FK) as printers for the PC without a need to link both devices via a telecommunications network. The link of such a PC to a facsimile FAX (FK) can advantageously take place by means of the two N*connections of TAE-NFN** junction or connection box. For * and **, see translator's note on page 7.

The facsimile FK and the PC each inherently have connection circuits to a public telephone network or telecommunications network and are by-passed or isolated from such network when the FAX FK is used as a printer for the PC through the direction link between the two. Because the facsimile FK is used as a printer for the PC, the direct communication link between the two, which is without the aid of a telecommunication network, is a passive link between the two, and signals communicated therebetween are non-intercepted. Though the claims use terminologies different from Simon's disclosure, the meaning of the claim content and the meaning of Simon's invention are interpreted to be the same.

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Regarding claim 44, note that the direct link between the facsimile FK and the PC is a single, serial link (Fig. 3, page 6, the complete paragraph 2).

Regarding claim 45, Simon also teaches use of a parallel port for parallel communication between the PC and facsimile machine FK (prior art Fig. 2). Therefore, parallel data transmissions is not patentable subject matter.

Regarding claims 46 and 47, the signals being communicated between the direct communication link between the facsimile and PC are analog signals. Simon's disclosure does not clearly show transfer of digital data between the facsimile FK and PC. Further, in claim 47, the claim limitation "using analog data transmissions" is taken as the claim limitation for the purpose of this rejection. Thus, the claimed phrase "digital serial, or parallel signals" is not considered.

Claim 48, which depends upon claim 43, is rejected in the rejection for claim 43 since "printer" is taken as the claim limitation from the limitation(s) "as a scanner or printer" on line 1 of claim 43, for the purpose of this rejection.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 27, 29, 33, 35, 36, 38, 40, 43, 44, 47, 52, 53, and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakamura et al. (U.S. Patent No. 5,608,546), cited in Paper No. 4, dated May 19, 1997.

Regarding claim 27, Nakamura et al. discloses a method of using a facsimile apparatus (FAX1) as scanner and a printer for a personal computer (PC) (Figs. 1 and 2, col. 4, lines 1-45, col. 5, line 40 - col. 6, line 2). In the PC-FAX mode, data is directly transferred or transferred through a passive link from FAX1 to PC. Here, "a passive link" is interpreted to mean a communication link without the involvement of a communications network. FAX1 is provided with a port RS-232C, which is a standard digital interface. When FAX1 is used as a scanner for PC, an original image read by the reading unit (2) of FAX 1 is transferred as digital data from the FAX1 port RS-232C to the PC. When FAX1 is used as a printer for PC, digital data transferred from PC to the port RS-232C of FAX1. FAX1 and PC are isolated from the public telephone line L (Figs. 1 and 2) and are coupled to each other. PC and FAX1 are conditioned to receive

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digital data version of the scanned image from and transmit digital data to port RS-232C of FAX1, respectively.

Regarding claim 29, when FAX1 is used as a scanner for PC, the link is passive between the two and the digital data transferred from the RS-232C port of FAX1 to PC is considered non-intercepted. It is inherent that the digital data, once received at PC, are processed by PC.

Regarding claim 33, the standard RS-232C port (interface) is a serial-digital-data interface.

Claim 36 recites limitations similar to those of claim 27. The limitation (lines 2-3 of the claim) “each of the facsimile machine and personal computer for communicating normally using at least one public network telephone line” is met by Nakamura’s FAX1 communicating in a fax mode using the telephone line L and PC communicating using the telephone line L (using FAX1 as a facsimile modem). The two kinds of communicating are considered normal. Further, both FAX1 and PC are connect with a digital connector port RS-232(C). The digital data from scanning or for printing are communicated between FAX1 and PC are not intercepted by any communications network. In the PC-FAX mode, FAX1 and PC are both isolated from the telephone line L. The shifting to a connection mode of PC with FAX1 is inherent when PC is placed in the PC-FAX mode. Also see discussion for claim 27.

Regarding claim 38, see port RS-232.

Regarding claim 40, from the limitation(s) “using RS 232, parallel or other suitable digital port type connectors ...”, the limitation “other” “digital port type connector” is selected as

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the claim limitation rather than “RS 232, parallel”. Thus, Nakamura still meets the claim limitation since the RS-232 is a digital port connector for interfacing FAX1 and PC.

For claim 43, see discussions for claims 36 and 27, for claim 43 claiming limitations similar to those of claims 36 and 27. Unlike claims 36 and 27, claim 43 does not claim “digital data” transfer or communication. However, Nakamura still applies. In addition, with regard to the claimed simulated “off-hook condition” or “connection mode” in parts (b) and (c) of the claim, in the PC-FAX mode of Nakamura, i.e., when the FAX1 and PC are isolated from the public telephone network (to which L is connected) during which mode FAX1 is used as a scanner or a printer for PC, FAX1 and PC are put in a simulated “off-hook condition.”

For claim 44, see discussion for claim 33 above.

Regarding claim 47, from the claim limitations “analog data transmissions, or digital serial, or parallel signals”, the limitation digital serial signals is selected for the purpose of this rejection. As discussed above, the RS-232 port of Nakamura is a digital serial interface.

Regarding claims 52 and 53, Nakamura was discussed for claim 43 above. (See also discussions for claims 36 and 27.) Like claim 43, claims 52 and 53 do not specifically claim “digital data” transfer or communication. Claims 52 and 53 claim that the facsimile machine operates as a scanning device and as a printer, respectively. Thus, Nakamura, which discloses using FAX1 both as a scanner and as a printer, discussed for claim 43 also meets the claims 52 and 53.

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For claim 35, which depends upon claim 53, see discussion for claims 53, 52 and 43 with regard to FAX1 used as a printer for PC when isolated from the telephone line L.

For claim 54, see discussion for claims 36 and 27. Claims 54 and 36 both claim, among other limitations, digital data transfer or using digital connection between the facsimile machine and the computer, and both claim that each of the facsimile machine and computer is for communicating normally using at least one public networking telephone line (in preamble). These limitations are discussed for claim 36 with reference to Nakamura. The other limitations are also discussed for claims 36 and 27. Please refer to discussions for those claims.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 41, 42 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (5,608,546) in view of well known art.

Claim 41 recites "method of claim 27 further comprising optically recognizing the scanned data and converting the scanned data into character codes." This feature is not specifically disclosed by Nakamura. The examiner took Official Notice of the fact conversion of scanned data to character codes to be used in a computer is not novel and is a well known feature

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in the art of optical character recognition. It is noted that the claim does not define where the data is converted, i.e., in the facsimile machine, in the computer or in anywhere outside the two, and if the converted character codes are transferred at all to anywhere. To the extent of the claim, it would have been obvious to one of ordinary skill in the art to apply character recognition to the scanned data of Nakamura to obtain character codes so that the codes are acceptable by the computer.

Claim 42 is rejected for the same reasons as given for claim 41 above, for claim 42 claiming the same limitations as those of claim 41.

Claim 48 is rejected for the same reasons as given for claim 42 above, the claim 48 claiming the same limitations as those of claim 42.

11. Claims 32, 39 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (5,608,546) in view of Simon (DE 43 12 136, English translation).

Regarding claims 32, 39 and 45, Nakamura does not disclose parallel data transmission (port) between the FAX1 and PC. However, such parallel connector port for interfacing a facsimile machine and a computer (personal computer PC) is not a novel feature and therefore is not patentable subject matter. Simon shows in prior art Fig. 2 a parallel port in addition to a serial port for communicating between a facsimile machine FK and a PC (see middle of page 5 of translation and prior art discussion of Fig. 2 on previous pages).

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Since Simon's prior art is directed to a direct link between the PC and the fax FK without the need of a network, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the idea of Simon of employ also a parallel port for parallel transmission between the FAX1 and PC of Nakamura for a direct link between the facsimile apparatus and the computer to provide an additional option for a simple data transfer processor for the user.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee at telephone number (703) 305-4867.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9306 (for formal communications intended for entry)

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA
Sixth Floor (Receptionist)

C. L.
Jan. 8, 2004

A handwritten signature in black ink, appearing to read "Cheukfan Lee". The signature is stylized with a large, looping initial "C" and "L".